

REMARKS

Reconsideration and withdrawal of the rejections set forth in the Office action dated July 12, 2006 are respectfully requested. Applicant thanks the Examiner for an indication that claims 15-22, 31, and 34-37 are allowable and claims 4-5, 8, 13-14, and 32-33 would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claim.

I. Amendments

Claims 1 and 17 are amended to recite a heat activated adhesive bond and heat activated adhesive, respectively. Basis for these amendments can be found, for example, on page 10, lines 28-30.

Claims 4 and 18 are amended for consistent terminology with claims 1 and 17.

New claims 38-39 find basis in claims 1 and 17, respectively.

Claim 23 is amended to clarify the method steps. Basis for this amendment can be found on page 13, line 24 through page 14, line 8.

Claim 24 is amended in accord with the Examiner's kind suggestion.

No new subject matter is added by way of these amendments.

II. Rejections under 35 U.S.C. §112, first paragraph

Claims 23-30 were rejected under 35 U.S.C. §112, first paragraph as allegedly failing to comply with the written description requirement. Specifically, the Examiner objected to the HDL test pad in the laminate being in simultaneous contact with both a reagent pad and an HDL assay element. Claim 23 is amended to clarify that the laminate comprises a reagent pad and an HDL test pad as described at least on page 13, line 24 through page 14, line 8.

In view of the above, Applicant submits that the present claims satisfy the requirements of §112, first paragraph and respectfully requests that the rejections be withdrawn.

III. Rejections under 35 U.S.C. §112, second paragraph

Claims 23-30 were rejected under 35 U.S.C. §112, second paragraph as allegedly indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicant regards as the invention. Specifically, claim 23 was rejected as indefinite where it recites a HDL test pad having a detectable indicator of HDL cholesterol in simultaneous contact with both a reagent pad and an HDL assay element. In view of the amendments to the claim, Applicant respectfully requests withdrawal of the amendment to claim 23.

Further, the language "said sample reservoir" in claim 24 was objected to as lacking antecedent basis. Applicant has amended the claim in accord with the Examiner's kind suggestion.

In light of the above, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. §112, second paragraph.

IV. Rejections under 35 U.S.C. §102

Claims 23-30 were rejected under 35 U.S.C. §102(e) as allegedly anticipated by Jones *et al.* (US Patent Application No. 2005/0208609).

These rejections are respectfully traversed for the following reasons.

A. The Present Claims

The present invention, as embodied by claims 23-30, relate to a method of measuring serum cholesterol associated with HDL in a blood fluid sample.

B. The Cited Art

JONES ET AL. Under M.P.E.P. § 2136.05, a 35 U.S.C. 102(e) rejection can be overcome by showing the reference is describing the applicant's own work. Such a showing may be met by a Declaration under 37 C.F.R. § 1.132 by the applicant stating that he/she conceived or invented the subject matter disclosed in the patent or application publication and relied on in the rejection (*In re DeBaun*, 687 F.2d 459, 214 USPQ 933 (CCPA 1982)).

Applicant encloses herewith such a Declaration under 37 C.F.R. § 1.132 by Ronald M. Jones who is a named inventor on the present application as well as U.S. Application No. 2005/0208609. Accordingly, Applicant submits that the Jones *et al.* application is not an effective document under 35 U.S.C. § 102(e).

C. Analysis

In view of the enclosed Declaration under 37 C.F.R. § 1.132, Applicant respectfully requests withdrawal of the rejections under 35 U.S.C. § 102(e).

V. Obviousness-type Double Patenting Rejections

Claims 1, 6-7, and 11-12 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being directed to an invention not patentably distinct from claim 35 of co-owned U.S. Patent Application No. 10/981,981.

Applicant respectfully requests that this rejection be held in abeyance until such time as the claims are allowed in one of the applications.

Claims 1, 9-10, 23-24, 26, and 28-29 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being directed to an invention not patentably distinct from the pending claims 29, 31, 33, and 36-42 of co-pending U.S. Application No. 11/109,526.

A Terminal Disclaimer prepared in accordance with 37 C.F.R. §1.321(b) and (c) is enclosed. The signed Terminal Disclaimer obviates this obviousness-type double patenting rejection.

VI. Conclusion

In view of the foregoing, Applicant submits that the claims pending in the application are in condition for allowance. A Notice of Allowance is therefore respectfully requested.

If in the opinion of the Examiner, a telephone conference would expedite the prosecution of the subject application, the Examiner is encouraged to call the undersigned at (650) 838-4410.

Respectfully submitted,



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